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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,076	12/29/2000	James H. Wang	11302-1060 (44040-251537)	3501
29843	7590	03/31/2004	EXAMINER	
JOHN S. PRATT KILPATRICK STOCKTON LLP (KIMBERLY CLARK) 1100 PEACHTREE STREET SUITE 2800 ATLANTA, GA 30309			MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/753,076	Applicant(s) WANG ET AL.	
	Examiner Jeffrey C. Mullis	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-02; 7-02</u> | 6) <input checked="" type="checkbox"/> Other: <u>Appendix A</u> . |

It is noted that the Information Disclosure Statement of July 2, 2002 indicates that the first named inventor is Vasily Topolkaraev. As far as the Examiner knows, this is incorrect. Applicants' Information Disclosure Statement has therefore been corrected to recite that the first named inventor is Wang.

Applicant's election of the species of poly(hydroxybutyrate-co-hydroxyvalerate) as the first biodegradable polymer and 2-hydroxyethyl methacrylate as the polar monomer and polylactide as the second biodegradable polymer in Paper Nos. 1-4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 21-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The term "analogs" is unclear since it is subjective as to what material may be an analog of another.

The term "improved" has no meaning except with reference as to some other unnamed preference level to which improvement takes place. Furthermore, it is subjective as to what is "improved" in that said improvement may or may not be considered desirable by

all practitioners.

Claims 1, 2, 5, 6, 8, 9, 20 and 25-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Grimaldi et al. (CAPLUS AN 1996: 759389).

Grimaldi et al. disclose a composition containing polycaprolactone and poly(beta-hydroxybutyrate-co-beta-hydroxyvalerate) which are grafted with each other. Note the Abstract.

Claims 1, 7 and 10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hughes et al. (USP 5,420,211).

Hughes et al. disclose a composition containing biodegradable graft polymers made by grafting substrates such as polyalkylene oxides and/or polyalkoxylated materials. Note the Abstract. Monomers such as HEMA may be used at column 3 lines 18-30.

Claims 2, 8, 9, 11-15, 21 and 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes et al., cited above.

With regard to applicants' specific grafting monomers, there are no specific examples in Hughes utilizing such monomers. However Hughes et al. specifically disclose that such monomers may be used. Therefore it would have been obvious to a practitioner having ordinary skill in the art at the time of the

invention to use applicants' monomers in the embodiment utilizing both the ethylene oxide and polyalkoxylated materials in the expectation of adequate results absent any showing of surprising or unexpected results. With regard to the use of specific amounts of two different substrates as recited by the claims, Hughes discloses that either one or both substrates may be used and therefore implies that any amount between 0 and 100% may be used with either one and therefore choice of applicants' amounts as in instant claim 2 would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimaldi et al., cited above in view of Wang et al. (USP 5,945,480).

Grimaldi et al. does not disclose the production of films and fibers. However Wang et al. discloses that biodegradable materials are useful as films and fibers at column 2 lines 21-31.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to form the materials of Grimaldi et al. into films and fibers as taught by Wang et al. since Wang et al. discloses that biodegradable materials are especially useful and in the expectation of

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increasing the value of the materials of Grimaldi et al. absent any showing of surprising or unexpected results.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,552,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the concept of a product of applicants would have been obvious to a practitioner given that the method produces such a product; and with regard to the use of applicants' specific species, choice of applicants' specific species from that of the patent would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation of adequate results since all

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species are expected to work absent any showing of surprising or unexpected results.

Claims 1-3 and 5-27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending application Serial No. 09/753,077. Although the conflicting claims are not identical, they are not patentably distinct from each other because choice of applicants' species from that of application '077 would have been obvious to a practitioner having ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The search has been extended to the species cited in the above patents relied upon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (571) 272-1075. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be

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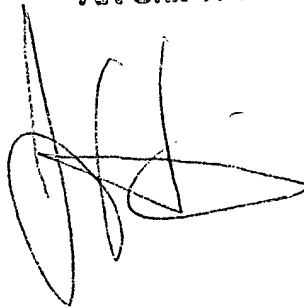
reached on (571) 272-1078. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

J. Mullis:cdc

March 23, 2004

Jeffrey Mullis
Primary Examiner
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A handwritten signature in black ink, appearing to be 'JM', is written over the typed name and title of the Primary Examiner.